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OFFICE OF PETITIONS

In re Application of :
Metz et al. :
Application No. 08/657,749 : ON PETITION
Filed: May 30, 1996 :
Attorney Docket No. 16518.025 :

This is a decision on the petition under 37 CFR 1.137(b), filed on September 5, 2001, to revive the above-identified application.

The petition is **DISMISSED**.

A non-final Office Action was mailed on June 23, 1998 ("6/23/98 Office Action"), setting forth a 1-month shortened statutory period for reply. A request for a 3-month extension of time (Certificate of Mailing date October 21, 1998) was filed on October 26, 1998, extending the due date for the reply to October 23, 1998.[1] However, no response was filed on or before October 23, 1998, and no further extensions of time were obtained under 37 CFR 1.136(a). Consequently, this application became abandoned on October 24, 1998 for failure to timely submit a proper reply to the 6/23/98 non-final Office Action.[2] A Notice of Abandonment was mailed on March 17, 1999.

Implied request to withdraw holding of abandonment

The instant petition alleges that a reply to the 6/23/98 Office Action was mailed on October 21, 1998, apparently implying that the application should not be held abandoned. In support, a copy of Applicants' postcard receipt bearing a PTO date-stamp of October 26, 1998 is enclosed.

A postcard receipt which itemizes and properly identifies the papers being filed would serve as *prima facie* evidence of receipt in the PTO of **all the items listed thereon** on the date stamped

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[1] The petition, on page 2, in essence argues that Applicants have extended the due date for reply by 4 months, because of the 3 months specifically requested and the "general authorization" for the PTO to charge for additional needed extensions of time for submitting the allegedly mailed 10/21/98 reply. This argument apparently is based on counsel's misunderstanding of the PTO rules. If a proper reply to the 6/23/98 Office Action cannot be proven to have been mailed as alleged, the "general authorization" is irrelevant. On the contrary, if the reply was indeed mailed on 10/21/98 with a proper certificate of mailing, it would have been considered "timely" when including the 3-month extension of timen obtained. Counsel's apparent belief that an additional month is required to cover the gap between 10/24/98 and 10/26/98 (PTO receipt date) is incorrect. See discussions, *infra*.

[2] 35 U.S.C. 133.

thereon by the PTO.[3] Unfortunately, Applicants' postcard receipt lists only 2 items: "Transmittal letter," and "Request for extension of time," both of which have been received by the PTO and are in the file for this application. Evidently, Applicants cannot rely on this postcard to support the assertion that a reply, which is not listed on this postcard, was received by the PTO on October 26, 1998.

Also submitted with the petition for supporting the above assertion is a copy of the October 26, 1998 transmittal letter for the allegedly mailed reply, showing a Certificate of Mailing date of October 21, 1998. Correspondence in response to an Office action will be considered timely filed in the PTO if it is deposited as first class mail with the U.S. Postal Service in accordance with the procedure set forth in 37 CFR 1.8(a). However, when such a correspondence is not received by the PTO, and in order to have the non-received correspondence considered timely filed, i.e., filed on the date shown in the certificate of mailing, 37 CFR 1.8(b)(3) requires a statement **attesting on a personal knowledge basis** . . . to the previous timely mailing. The contention that a reply to the 6/23/98 Office Action was mailed on October 21, 1998 as indicated by the certificate of mailing does not appear to be based on personal knowledge[4] and is likewise not convincing. The holding of abandonment for this application thus is not withdrawn.

Petition under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a grantable petition to revive an abandoned application must be accompanied by: **(1) the required reply to the outstanding Office action** or notice, unless previously filed;[5] (2) the petition fee as set forth in 37 CFR 1.17(m); **(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional**; and (4) a terminal disclaimer and the accompanying fee for a utility application filed before June 8, 1995, as required by 37 CFR 1.137(d).[6]

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[3] MPEP section 503 (Aug. 2001). See also 37 CFR 1.6 (Receipt of correspondence).

[4] The practitioner signing the instant petition was appointed by the assignee of this application, CALGENE LLC, to prosecute this application in a Power of Attorney executed on 4/13/01 and filed in the PTO on 5/22/01, 2½ years after 10/21/98, and appears to have made this statement based on hearsay rather than personal knowledge.

[5] A required reply in the instant case may be either: an amendment that appears throughout to be a *bona fide* attempt to advance the application to final action, e.g., a proper election in response to the 6/23/98 restriction requirement; or, the filing of a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). See MPEP section 711.03(c)(III)(A)(2)(a) (Aug. 2001).

[6] Not applicable to this application.

Regarding (1) above, the 6/23/98 non-final Office Action contains a restriction requirement.[7] The reply submitted with the instant petition purports to elect Invention I which comprises Claims 1-13, 17, 29; but erroneously cancels Claims 4-16.[8] This reply is thus non-responsive to the 6/23/98 non-final Office Action, and does not satisfy the provisions of 37 CFR 1.137(b)(1).[9]

As for item (3), **this application has been abandoned for over 3 years.** The instant petition merely indicates that "the entire delay was unintentional" but does not contain the statement required by 37 CFR 1.137(b)(3).

The petition to revive under 37 CFR 1.137(b) is thus dismissed.

Any request for reconsideration of this decision (no fee), to be grantable, must be:

-accompanied by:

-a proper election required in item (1) above; and
-a statement, required in item (3) above, that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional;

-filed within **TWO (2) MONTHS** from the mailing date of this decision unless proper extensions of time are obtained under 37 CFR 1.136(a);[10] and

-addressed as instructed below:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By fax: (703)308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

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[7] Paper No. 13.

[8] The elected Invention I is claimed partly in Claims 4-13.

[9] See MPEP section 711.02(a) (Aug. 2001) (Abandonment may result . . . where applicant's reply is timely but is not fully responsive to the Office action.), and 711.03(c)(III)(A) (Aug. 2001) (Generally, the "required reply" [under 37 CFR 1.137(b)(1)] is the reply sufficient to have avoided abandonment, had such reply been timely filed.).

[10] 37 CFR 1.137(e)(1).

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.

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